

REMARKS

The application has been revised in light of the Final Office Action mailed January 6, 2005. Claims 46-48 and 50-56 are currently pending in this application. By this amendment, Claims 46 and 48 have been amended to correct minor editorial problems. No new matter or issues have been introduced by this amendment. In view of the amendments above and the remarks to follow, reconsideration and allowance of this application are respectfully requested.

Terminal Disclaimer

The Terminal Disclaimer filed on August 30, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 5,383,888 was reviewed and was not accepted by the Examiner because an attorney not of record signed the Terminal Disclaimer in the capacity as an attorney acting in a representative capacity.

It is respectfully submitted that a proper power of attorney dated February 15, 2005 has been filed. Moreover, a new Terminal Disclaimer is attached hereto signed by an attorney of record. Consideration of the Terminal Disclaimer is respectfully requested.

Claim Objection

Claim 48 was objected to because the word “graspers” was misspelled in line 2. Claim 48 has been amended to correctly spell the word “graspers.” Therefore, reconsideration and withdrawal of this objection is respectfully requested.

Claim Rejection under 35 U.S.C. § 112

Claims 46-38 and 51-56 were rejected under 35 U.S.C. §112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regards as the invention. More specifically, the Examiner states that “tubular portion

(20) of the endoscopic portion is described as being fixed in line 30 of page 8 of the specification.” As such, the Examiner finds the recitation “an endoscopic portion extending distally from and being rotatable in relation to the handle portion...” in Claim 46 to be unclear. Applicants respectfully disagree.

The subject matter of Claim 46 is believed to be clear and fully supported by the disclosure of the application as filed. The disclosure describes endoscopic surgical instrument 10 as having “a mechanism for rotating the endoscopic portion 18 about its longitudinal axis relative to handle portion 12.” Page 11, line 11-13. The use of the term “fixed tubular portion (20)” on line 30 of page 9, refers to tubular portion (20) of endoscopic portion 18 being non-articulating as compared to section 22 which is articulating. The recitation in Claim 46 that the endoscopic portion is rotatable in relation to the handle portion is further supported by the specification on page 9, lines 5-25. However, in order to avoid any possible confusion, page 8, line 30 of the specification has been amended to recite ... “non-articulating or fixed tubular section 20...”.

Accordingly, Claim 46 and Claims 47-48 and 51-56, which depend therefrom, are believed to particularly point out and distinctly claim the subject which Applicants regard as the invention. Therefore, reconsideration and withdrawal of the rejection under 35 USC § 112, second paragraph is respectfully requested and allowance of the claims is earnestly solicited.

Claim Rejection under 35 U.S.C. § 102

Claims 46-48, 51-53 and 55 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,880,015 (Nierman). With regard to independent Claim 46 and Claims 47-48 and 51-53, which depend therefrom, Nierman does not teach or suggest an endoscopic surgical apparatus comprising an endoscopic portion extending distally from and being rotatable in relation to the handle portion, as recited in amended Claim 46.

In contrast, the flexible shaft 45 disclosed in Nierman is not rotatably mounted to the handle 44. Instead, flexible shaft 45 is fixed to handle 44 and only the articulation portion 54, cooperating jaws 46 and element 55 is permitted to pivot or bend about the longitudinal axis of flexible cable 45. See Column 8, lines 67-68 through Column 9, lines 1-3. Contrary to the Examiner's position stated in the Office Action, Column 2, lines 36-42 of Nierman expressly states that in order to direct a bronchoscope to the right or left, the entire instrument must be rotated.

Accordingly, Claim 46 and Claims 47-48 and 51-53, which depend therefrom, are believed to be patentably distinct over Nierman. Therefore, reconsideration and withdrawal of the rejection is respectfully requested and allowance of the Claims is earnestly solicited.

Claim Rejection under 35 U.S.C. § 103

Claim 54 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Nierman in view of U.S. Patent No. 5,350,391 to Iacovelli. It is respectfully submitted that Claim 54 is patentable for at least the reasons that independent Claim 1 is patentable, as discussed hereinabove. Therefore, reconsideration and withdrawal of the rejection is respectfully requested and allowance of the claim is earnestly solicited.

Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that none of the references of record, considered individually or in combination, in whole or in part, disclose or suggest the present invention as claimed. Therefore, all Claims now pending in this application, namely Claims 46-48 and 50-56, are now in condition for allowance. Accordingly, early and favorable consideration of this application is respectfully requested. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any

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remaining matters, he is respectfully requested to contact Applicant's undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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